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In The
Supreme Court of the United States

October Term, 1995

WARNER-JENKINSON COMPANY, INC.,

Petitioner,

vs.

HILTON DAVIS CHEMICAL CO.,

Respondent.

*On Petition for a Writ of Certiorari to the United States
Court of Appeals for the Federal Circuit*

RESPONDENT'S BRIEF IN OPPOSITION

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**LIST OF PARTIES PURSUANT TO
RULES 14.1(b) AND 29.6**

The names of all parties in the court whose judgment is sought to be reviewed appear in the caption of this Brief.

Respondent has the following parent and subsidiary companies:

Freedom Chemical Company (parent)

A Chem (UK) Limited (subsidiary)

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Respondent respectfully requests that this Court deny the Petition to review the judgment of the United States Court of Appeals for the Federal Circuit in this case. The question posed by Petitioner has been answered repeatedly by this Court over the last 140 years, beginning with *Winans v. Denmead*, 56 U.S. (15 How.) 330 (1853), and culminating with the polestar decision in *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605 (1950), which elegantly and definitively restated the well-established Doctrine of Equivalents in patent law. During the last 45 years, hundreds of trial and appellate courts have followed the clear principle of *Graver Tank* to assure that patent owners enjoy the full measure of their inventions. On August 6, 1995, the Court of Appeals for the Federal Circuit, charged by Congress to unify the patent law, after spirited debate, the enlightened wisdom of its full *en banc* membership, and the assistance of numerous *amici curiae*, restated the *Graver Tank* principle of the Doctrine of Equivalents as wise and pragmatic law.

Petitioner, by challenging the Doctrine of Equivalents itself, seeks to destroy one of the most important bulwarks underlying our country's patented technology. To deny certiorari in this case assures the continuance of this necessary rule of law. To grant certiorari, and to adopt the position of Petitioner, returns our technology to the dark ages where anyone can "practice a fraud on a patent" simply by making "unimportant and insubstantial changes" — an anathema to this Court's wisdom of *Graver Tank*.

COUNTERSTATEMENT OF THE CASE

This action involves a unique and valuable patent owned by Respondent, Hilton Davis. The patent covers an innovative complex chemical process for producing two specific synthetic red and yellow food dyes: FD&C (food, drug and cosmetic) Red 40 and FD&C Yellow 6.¹ The patented process was the first to

1. These dyes are widely used as colorants in many popular food products including M&M's, Kool Aid and numerous soft drinks. Hilton Davis
(Cont'd)

successfully purify these food dyes to the extremely high purity required by the FDA for human consumption without the use of a very costly and environmentally undesirable step known as "salting out". This laborious and expensive "salting out" process involved adding large quantities of rock salt to cause the dye to crystallize out of solution, filtering the crystalline dye in large filter presses to produce a semi-solid press cake, manually scraping the press cake from the filter, subjecting the press cake to a series of successively more dilute salt solution washes, redissolving the press cake in water, and finally evaporating the solution to produce the dry dye. The patented process eliminates most of those steps.

In 1982, the inventors of the patented process, Drs. Cook and Rebhahn, led the search for a commercially viable alternative to the "salting out" process. The inventors conceived a revolutionary approach using a membrane separation process, now known as "ultrafiltration," to separate the impurities in the dye solution from the dye molecules. A major concern was whether the new Hilton Davis process could remove the organic impurities, particularly the Schaeffer's salt impurity, because of the small differences in size between the impurity molecules and the dye molecules.

Hilton Davis hired Osmonics under a secrecy agreement to test the new process under the direction and supervision of Dr. Cook on a Red 40 solution prepared by Hilton Davis. It immediately became apparent that Osmonics lacked the experience to remove organic impurities from dyes, or to purify dyes to the level of purity required by Hilton Davis to meet stringent FDA specifications. Following the test, Dr. Cook analyzed the test results and determined that the test was unsuccessful in meeting Hilton Davis' objectives. At that point,

(Cont'd)
and Warner-Jenkinson are the only domestic producers of these important dyes.

Dr. Cook made the critical and inventive realization that the essence of a viable process was to obtain a proper trade-off between dye loss and impurity removal. To validate this ingenious discovery, Dr. Cook instructed Osmonics to perform a second test with changes to the membranes and test procedures which he specified.

This second test of the Hilton Davis Red 40 dye solution by Osmonics under the direction of Dr. Cook in October 1982 was successful. Subsequently, the Yellow 6 dye solution was successfully purified using the Hilton Davis process under Dr. Cook's direction in January 1983. Osmonics had nothing to do with the invention of the Hilton Davis process for purifying either of these dyes.

Drs. Cook and Rebhahn then filed their initial patent application based on the October 1982 and January 1983 tests. After extensive further in-house testing by Dr. Cook, Hilton Davis filed a continuation-in-part (CIP) application claiming a broader range of membranes. The final claim language incorporated the specific combination of process conditions found by Dr. Cook to meet his objectives, particularly tradeoffs which he had discovered between dye loss and the amount of impurities passing the membranes to produce an efficient, commercially practical purification process.

Claim 1 of the Hilton Davis patent, which issued in 1985, reads in part as follows:

In a process for the purification of a dye selected from [a group including Red 40 and Yellow 6] ... the improvement which comprises: subjecting an aqueous solution ... to ultrafiltration through a membrane having a nominal pore diameter of 5-15 Angstroms under a hydrostatic pressure of

approximately 200 to 400 p.s.i.g., at a pH of approximately 6.0 to 9.0, to thereby cause separation of said impurities from said dye, said impurities of a molecular size smaller than the nominal pore diameter passing [through] said membrane and said dye remaining in the concentrate, and when substantially all said impurities have been removed from said concentrate ... recovering said dye, in approximately 90% purity from said concentrate by evaporation of said concentrate to dryness.

During prosecution of the Hilton Davis patent application, the Patent Office initially rejected the claims as obvious in view of the prior art Booth patent. To distinguish from the Booth patent, Hilton Davis noted four important distinctions: (1) the enormous differences between the molecular weights of the dyes purified by Booth and those purified by the Hilton Davis process; (2) the intentional addition of salt to the solution required by the Booth process, antithetical to the elimination of "salting out"; (3) the very high pH ranges deliberately required in the Booth process (above 9.0 and preferably 11-13), in contrast to the relatively low pHs used in the Hilton Davis process (below 9.0); and (4) the very low pressures used in the Booth process (25-200 p.s.i.g., preferably 75-125 p.s.i.g.), in contrast with the much higher pressures required by the Hilton Davis process: 200-400 p.s.i.g. After that combination of distinguishing features was pointed out to the Patent Examiner, the Hilton Davis patent issued.²

2. In its opinion, the Federal Circuit states that "[t]he inventors added the phrase 'at a pH from approximately 6.0 to 9.0' during prosecution to distinguish [the Booth patent]." 62 F.3d at 1515-16. This statement is not entirely correct. The Court later correctly explained that the pH range was added to avoid the disclosure in Booth of a process operating at a pH higher

(Cont'd)

Warner-Jenkinson developed its infringing process on a parallel, but not completely independent, path. In 1978, Warner-Jenkinson unsuccessfully experimented with the Booth process, which used "salting out", and completely abandoned its process development efforts until August 1982. After resuming work, Warner-Jenkinson unsuccessfully tested a filtration process at Osmonics which continued to incorporate a "salting out" step. After this failure, Warner-Jenkinson, unable to produce a viable process, again abandoned work on filtering Red 40 and Yellow 6.

In 1986, after four years of inactivity, and under very suspicious circumstances, Warner-Jenkinson unexpectedly demonstrated a process which eliminated the "salting out" step by using the patented Hilton Davis process. This sudden success was no coincidence. Osmonics used confidential information learned during testing of the Hilton Davis process under the direction of Dr. Cook to overcome the deficiencies in the failed Warner-Jenkinson process.³ Even more remarkable, the infringing Warner-Jenkinson process used the same equipment and membranes as the Hilton Davis process. There was clear evidence presented below that the Warner-Jenkinson process was not developed independently, but was derived in its most critical and necessary attributes from the Hilton Davis process.

(Cont'd)

than 9. Consequently, while the claim amendment surrendered pHs above 9, it did not bar Hilton Davis from ascertaining the equivalency to processes operating at pHs below 9. *Id.* at 1525. Petitioner incorrectly asserts the claims were amended to recite 'a hydrostatic pressure of approximately 200 to 400 p.s.i.g.'. Pet. Br. at 5. That claim requirement was present in the application *ab initio* and was not added during prosecution to distinguish the Hilton Davis invention from the prior art.

3. Using confidential information learned from Hilton Davis during the successful tests of the patented process, Osmonics recognized the deficiencies in the failed Warner-Jenkinson process. Osmonics subsequently achieved success in the Warner-Jenkinson process only after the process was modified to use critical membranes and process parameters like Hilton Davis employed.

Warner-Jenkinson's deliberate use of the Hilton Davis process did not stop there. Even after learning of the Hilton Davis patent and warned of infringement, Warner-Jenkinson continued infringing. Rather than independently designing a clearly noninfringing process, Warner-Jenkinson doggedly sold enormous quantities of dyes made by the patented process.

The Warner-Jenkinson process uses a purification technique for purifying Red 40 and Yellow 6 which is equivalent to that claimed in the Hilton Davis patent, operating at a pH of 5-6 (the equivalent of the claimed pH of 6-9) and at a pressure of 200-500 p.s.i.g. (the equivalent of the claimed 200-400 p.s.i.g.). In fact, Warner-Jenkinson actually operated its process near, if not at pH 6, and in many instances with a pressure within the range of 200-400 p.s.i.g. supporting a finding of *literal* infringement of these claim limitations.

In the infringing Warner-Jenkinson process, the "function" of the pH is to: (1) prevent damage to the membrane; (2) produce a more or less neutral product required by the FDA; (3) be compatible with the chemistry of the process; and (4) destroy triazine.⁴ Warner-Jenkinson operated its infringing process with a pH meeting these functions. As to the "way" requirement, in the patented process, the pH is adjusted after coupling by means of an acid to obtain the desired value, just as in the infringing process. The "result" of utilizing the appropriate pH is that the membrane is not destroyed, the process operates to produce certifiable dyes, and triazine is destroyed — results achieved in the infringing process. Consequently, the *Graver Tank* function/way/result test is clearly met.

4. Warner-Jenkinson argues that it avoids infringement by operating at a lower pH which would cause so-called "foaming" in the Hilton Davis process. If one of the functions of pH is to prevent "foaming", the infringing Warner-Jenkinson process accomplishes that function. Moreover, the patented process was successfully tested to pH values as low as 2.2 with no effect on the process because of "foaming."

As to the pressure requirement, the "function" of the pressure is to exert sufficient force on the dye mixture applied to the upstream side of the membrane to overcome the osmotic pressure to drive water and impurities through the membrane at an economically useful rate. The "way" in which this function is achieved is by overcoming the osmotic pressure with additional pressure to force the water and impurities through the membrane while retaining the dye. The "result" achieved is that the water and impurities are removed to obtain a dye of a particular quality and dye concentration suitable for spray drying. Warner-Jenkinson's process used a functionally equivalent pressure meeting the *Graver Tank* test.

In its Petition, Warner-Jenkinson creates the misleading impression that its process is fundamentally different from Hilton Davis'. The jury, the District Court and the *en banc* Federal Circuit all found otherwise: the differences between the patented and infringing process are no more than insubstantial.⁵

At trial, Hilton Davis pursued infringement under the Doctrine of Equivalents.⁶ After extensive evidence offered over nine days with nine expert and technical fact witnesses, the jury was properly instructed on the application of the Doctrine of Equivalents, particularly the function/way/result test.

The jury deliberated for several days, returning a verdict supported by nine special verdicts. The jury found that the Hilton Davis patent remained valid, that Warner-Jenkinson infringed

5. Warner-Jenkinson's approach is sometimes known as "tickling" the patent — a practice used by unscrupulous competitors to come as close as possible to a patented invention to obtain its benefits by making unimportant and insubstantial changes and substitutions — a practice condemned by this Court in *Graver Tank*, 339 U.S. at 607.

6. Petitioner does not challenge the equivalence of several other claim limitations in addition to pH and pressure, e.g., pore size and acid.

under the Doctrine of Equivalents⁷ (although not willfully), and awarded 20% of Hilton Davis' request for damages.

Briefing on Warner-Jenkinson's post trial motions consumed over 400 pages. The trial court denied those motions in a carefully reasoned oral opinion, holding specifically that there was substantial evidence to support the jury's finding of infringement under the Doctrine of Equivalents.⁸ The court also entered a narrowly drawn permanent injunction which permitted Warner-Jenkinson to continue practicing its process for Red 40 and Yellow 6 at a pressure above 500 p.s.i.g. or at a pH above 9.01.⁹ Within weeks after the entry of the injunction, Warner-Jenkinson was able to modify its process to be allegedly non-infringing.

On appeal, a panel of the Federal Circuit heard oral argument on July 9, 1993. Subsequently, the court decided *sua sponte* to hear the appeal *en banc* to answer three specific questions:

1. Does a finding of infringement under the Doctrine of Equivalents require anything in addition to proof of the facts that there are the same or substantially the same (a) function, (b) way, and (c) result, the so-called triple identity test of *Graver Tank v. Linde Air Prods. Co.*, 339 U.S. 605 (1950), and cases relied on therein? If yes, what?

7. Infringement under the Doctrine of Equivalents is a question of fact. *Graver Tank* 339 U.S. at 609. Since two courts have already considered these facts, they cannot be reconsidered. *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 336 U.S. 271, 275 (1949).

8. In a separate opinion, the Court of Appeals panel affirmed the District Court's decisions on post-trial motions involving validity. Warner-Jenkinson does not seek review of that ruling. Pet. Br. at 7, n.6.

9. Warner-Jenkinson was enjoined "from infringing claims 1, 2, 3, 13 or 14 of [the Hilton Davis patent] by selling or manufacturing FD&C Red 40 and FD&C Yellow 6 made at a pH less than 9.01 and at pressures at the input to the first membrane of less than 500 p.s.i.g." Pet. App. at 172a.

2. Is the issue of infringement under the Doctrine of Equivalents an equitable remedy to be decided by the Court, or is it, like literal infringement, an issue of fact to be submitted to the jury in a jury case?

3. Is application of the Doctrine of Equivalents by the trial court to find infringement of the patentee's right to exclude, when there is no literal infringement of the claim, discretionary in accordance with the circumstances of the case?

In its opinion of August 6, 1995, reported at 62 F.3d 1512, the Federal Circuit answered the first question that "the finding of infringement under the Doctrine of Equivalents requires proof of insubstantial differences between the claimed and accused products or processes." 62 F.3d at 1521-22. In answer to the second question, "infringement under the doctrine of equivalents is an issue of fact to be submitted to the jury in a jury trial with proper instructions, and to be decided by the judge in a bench trial." *Id.* at 1522. In answer to the third question, "[t]he trial judge does not have discretion to choose whether to apply the doctrine of equivalents when the record shows no literal infringement." *Id.* In addressing the merits of the appeal, the *en banc* Federal Circuit affirmed *per curiam* "[b]ecause substantial evidence supports the jury verdict of infringement." *Id.* at 1515.

REASONS FOR DENYING THE WRIT

I. THE QUESTION PRESENTED BY PETITIONER WAS ANSWERED BY GRAVER TANK WHICH REMAINS UNCONTROVERSIAL GOOD LAW.

The question presented by Petitioner has been answered repeatedly in the affirmative by this Court over the last 140 years, beginning with *Winans v. Denmead*, 56 U.S. (15 How.) 330

(1853), and culminating with the *Graver Tank* decision. In that decision, this Court definitively ruled that infringement may be established where the accused device "performs substantially the same function in substantially the same way to obtain the same result," *Graver Tank*, 339 U.S. at 608 (quoting *Sanitary Refrigerator Co. v. Winters*, 280 U.S. 30, 42 (1929)). This is the classic definition of the Doctrine of Equivalents. The Court reasoned that "to permit imitation of a patented invention which does not copy every literal detail would be to convert the protection of the patent grant into a hollow and useless thing." *Id.* at 607. What Petitioner truly seeks here, without any valid reason, is the extermination of the Doctrine of Equivalents by having this Court overturn *Graver Tank* and its venerable predecessors and, as a result, the evisceration of the United States patent system. In the court below, none of the concurring or dissenting opinions or the many *amici curiae* suggested such Draconian measures. Nor has special justification been shown for overruling *Graver Tank*. The type of weakened conceptual underpinnings, irreconcilable competing legal doctrines or policies, inherent confusion created by an unworkable decision, direct obstacles to important objectives in other laws, or inconsistency with sense of justice or social welfare, which justify overruling precedent, do not exist in this case. See *Patterson v. McLean Credit Union*, 491 U.S. 164, 173-74 (1988). In the decision below, the Federal Circuit — the court created by Congress to bring consistency and coherence to patent law — has acted "to restate — not to revise — the test for infringement under the doctrine of equivalents." 62 F.3d at 1516. It is a waste of this Court's scarce judicial resources to simply revisit and again restate the well-established *Graver Tank* principle.

This Court's decision in *Graver Tank* did not spring forth on a sudden whim. Rather, *Graver Tank* is a well-reasoned unexceptional restatement of the Doctrine of Equivalents

established by a long line of prior precedent.¹⁰ This Doctrine had even more basic roots in the English Common Law.¹¹ An acknowledgement of equivalency can be found in a patent granted by English Parliament in 1695. Christine MacLeod, *INVENTING THE INDUSTRIAL REVOLUTION: THE ENGLISH PATENT SYSTEM 1660-1800* 73 (1988). In spite of this long and unbroken history, and without sound justification, Petitioner asserts this Court should "revisit" the Doctrine of Equivalents. Such "revisiting" is unwarranted.¹²

10. See *Sanitary Refrigerator Co. v. Winters*, 280 U.S. 30 (1929); *Singer Mfg. Co. v. Cramer*, 192 U.S. 265 (1904); *Coupe v. Royer*, 155 U.S. 565 (1895); *Belding Mfg. Co. v. Challenge Corn Planter Co.*, 152 U.S. 100 (1894); *Royer v. Schultz Belting Co.*, 135 U.S. 319 (1890); *Imhaeuser v. Buerk*, 101 U.S. 647 (1879); *Paper Bag Machine Co. v. Murphy*, 97 U.S. 120, 125 (1878); *Ives v. Hamilton*, 92 U.S. 426 (1875); *Sewell v. Jones*, 91 U.S. 171 (1875); *Duff v. Sterling Pump Co.*, 107 U.S. 636 (1883); *Roberts v. Ryer*, 91 U.S. 150 (1875); *Brown v. Guild*, 90 U.S. (23 Wall.) 181 (1874); *Gill v. Wells*, 89 U.S. (22 Wall.) 1 (1874); *Rees v. Gould*, 82 U.S. (15 Wall.) 187 (1871); *Seymour v. Osborne*, 78 U.S. (11 Wall.) 516 (1870); *Tyler v. Boston*, 74 U.S. (7 Wall.) 327, 330-31 (1868); *Case v. Brown*, 69 U.S. (2 Wall.) 320 (1864); *Burr v. Duryee*, 68 U.S. (1 Wall.) 531 (1864); *McCormick v. Talcott*, 61 U.S. (20 How.) 402 (1858); *Winans v. Denmead*, 56 U.S. (15 How.) 330 (1853); *Sloat v. Spring*, 22 F. Cas. 330, 334 (C.C.E.D. Pa. 1850) (No. 12,948a); *Gray v. James*, 10 F. Cas. 1015 (C.C.D. Pa. 1817) (No. 5,718); *Odiome v. Winkley*, 18 F. Cas. 581 (C.C.D. Mass. 1814) (No. 10,432).

11. See, e.g., *Heath v. Umwin*, 2 Websters Patent Cases 296 (H.L. 1855); *Stead v. Anderson*, 1 Websters Patent Cases 151 (C.P. 1847); *Hill v. Thompson And Forman*, 1 Websters Patent Cases 239 (C.P. 1818).

12. The obligation to follow precedent begins with necessity, and a contrary necessity marks its outer limit. With Cardozo, we recognized that no judicial system could do society's work if it eyed each issue afresh in every case that raised it. Indeed, the very concept of the rule of law underlying our own Constitution requires such continuity over time that a respect for precedent is, by definition, indispensable.

Planned Parenthood of Southeastern Pa. v. Casey, 505 U.S. 833, 120 L. Ed. 2d 674, 699 (1992).

As this history demonstrates, the Doctrine of Equivalents as reiterated by *Graver Tank* was not revolutionary as Petitioner contends, nor is it revolutionary today as reiterated by the Federal Circuit — no principle is more ingrained in patent jurisprudence. The basic premise of the Doctrine of Equivalents — that if the differences between two devices (or processes) are only insubstantial, then the devices “are the same, even though they differ in name, form, or shape” (*Graver Tank*, 339 U.S. at 608) — has long been the law of the land. See, e.g., *Paper Bag Machine Co. v. Murphy*, 97 U.S. 120, 125 (1878) (“if two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same, even though they differ in name, form, or shape.”)

Contrary to Petitioner’s unsupported contentions, there is no evidence that the Doctrine of Equivalents, as consistently applied by United States courts for the last 140 years, has “complicated,” “lengthened,” or “spurred” patent infringement litigation. See, e.g., Sean T. Moorhead, Note, *The Doctrine of Equivalents: Rarely Actionable Non-Literal Infringement or the Second Prong of Patent Infringement Charges?*, 53 OHIO ST. L.J. 1421, 1449 (1992) [hereinafter *Moorhead*] (noting that the Doctrine of Equivalents will “serve the system well” and will not be a cause of increased litigation). Since it was decided, over 800 cases have cited *Graver Tank* and applied the Doctrine of Equivalents, without apparent concern. For 45 years, this Court has not seen the need to revisit the Doctrine of Equivalents. Not a single reported opinion citing the Federal Circuit’s decision below has expressed concern about complications, uncertainty, or any other of the horrors envisioned by Petitioner.¹³ These courts do not

13. See, e.g., *Mason v. Tampa G. Mfg. Co.*, 1995 U.S. App. LEXIS 28368 at *12 (Fed. Cir. 1995); *Pall Corp. v. Micron Separations, Inc.*, 66 F.3d 1211, 1218 (Fed. Cir. 1995); *Ramos v. Biomet, Inc.*, 1995 U.S. App. LEXIS 25872 at *7 (Fed. Cir. 1995); *Ramos v. Boehringer Mannheim Corp.*, 1995 U.S. App. LEXIS 25870 at *4 (Fed. Cir. 1995); *Edward Lowe Industries v. Oil-Dri Corp. of America*, 1995 U.S. Dist. LEXIS 15136 at *26 (N.D. Ill. 1995); *HBB L.P. v.* (Cont’d)

view the Federal Circuit’s decision as expanding or otherwise revising the law of infringement. Rather, the courts perceive the decision as clarifying, rather than complicating, the law. See *Lucas Aerospace*, 1995 U.S. Dist. LEXIS at *35 (*Hilton Davis* reiterates “relevant gauges” to determine substantiality of differences). Petitioner’s notions of impending doom and chaos in the patent system are overblown.¹⁴

History has shown that the Doctrine of Equivalents advances and promotes several important policies of the United States patent system including protecting the patentee from unlawful infringement and encouraging technological innovation. Article I § 8 clause 8 of the United States Constitution authorizes Congress “[t]o promote the progress of Science and useful Arts, by securing for limited times to . . . inventors the exclusive right to their . . . discoveries.” To implement this fundamental principle, the federal patent system “embodies a carefully crafted

(Cont’d)

Ford Motor Co., 1995 U.S. Dist. LEXIS 14400 at *21-*22 (N.D. Ill. 1995); *General American Transp. Corp. v. Cryo-Trans, Inc.*, 897 F. Supp. 1121, 1125 n.3 (N.D. Ill. 1995); *Lucas Aerospace, Ltd. v. Unison Indus., L.P.*, 899 F. Supp. 126, 1995 U.S. Dist. LEXIS 13361 at *34-*36 (D. Del. 1995); *American Permehedge, Inc. v. Barcana, Inc.*, 1995 U.S. Dist. LEXIS 15838 at *14-*16 (S.D.N.Y. 1995); *Total Containment, Inc. v. Environ Prods., Inc.*, 1995 U.S. Dist. LEXIS 17229, at *88, *103-04 (E.D. Pa. 1995); *Hydraflow v. Enidine, Inc.*, 1995 U.S. Dist. LEXIS 17128 at *38 (W.D.N.Y. 1995)

14. In contrast, the Federal Circuit’s decision in *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995), cert. granted, 116 S. Ct. 40 (1995), immediately generated substantial concern. See, e.g., *Lucas Aerospace, Ltd. v. Unison Indus. L.P.*, 890 F. Supp. 329, 332 n.3, 333-34 n.7 (D. Del. 1995) (noting that *Markman* “leaves the reader, and the reviewing court, uninformed” and that *Markman*, creates a “practical problem in courtroom administration” that the court “confessedly does not know how to solve.”); see also *ELF Atochem N.A., Inc. v. Libbey-Owens-Ford Co., Inc.*, 894 F. Supp. 844, 857 (D. Del. 1995). No similar judicial criticism exists in the wake of the present case.

bargain for encouraging the creation and disclosure of new, useful, and nonobvious advances in technology and design in return for the exclusive right to practice the invention for a period of years." *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 150-51 (1988); Stephen G. Kalinchak, *Obviousness and the Doctrine of Equivalents in Patent Law: Striving for Objective Criteria*, 43 CATH. U.L. REV. 577, 580 (1994). The Doctrine of Equivalents has evolved from a balancing of competing policies that support this constitutional purpose "to promote the progress of Science and the useful Arts," including protecting the inventor from appropriations of the invention that barely avoid the literal language of the claims. Only "insubstantial changes" constitute infringement under the Doctrine of Equivalents. *Graver Tank*, 339 U.S. at 607; *Sanitary Refrigerator Co.*, 280 U.S. at 42; *Union Paper Bag Machine Co.*, 97 U.S. at 125; *Hilton Davis*, 62 F.3d at 1517, 1521-22. Accordingly, the Doctrine of Equivalents is necessary to "benefit the inventor's genius and not the scrivener's talents." *Autogiro Co. of America v. United States*, 384 F.2d 391, 399 (Ct. Cl. 1967). The Doctrine of Equivalents does not interfere with this policy or bargain.

Contrary to Petitioner's unsupported argument, the Doctrine of Equivalents is indispensable to a meaningful patent system because its application ensures that a patentee receives the full measure of protection against infringement to which he is legally entitled. The decision below expressly notes that this Court "explained in *Graver Tank* that the doctrine of equivalents prevents the unfairness of depriving the patent owner of effective protection of its invention." 62 F.3d at 1521. The Doctrine of Equivalents ensures that a patentee can receive full protection for his patented ideas by making it difficult for a copier to simply maneuver around a patent's claims by making only "insubstantial changes". Ronald E. Larson, *Balancing the Competing Policies Underlying the Doctrine of Equivalents in Patent Law*, 21 A.I.P.L.A. Q.J. 1, 11 (1993). As between a patent's functions of

"providing notice to the public" and "protecting the patentee", the latter, because it is constitutionally mandated, is more important and should, accordingly, be given more weight when a court must choose between the two. *See, supra, Moorhead* at 1427. *Graver Tank* recognized that protecting the patentee and providing the full benefit of the patented invention was paramount: "[t]he essence of the doctrine [of equivalents] is that one may not practice a fraud on a patent." *Graver Tank*, 339 U.S. at 608. The balance thus struck by *Graver Tank* is uncontroversial.

Although the United States has long recognized the importance of protecting a patentee's rights through the Doctrine of Equivalents, many foreign patent systems lack such protection; accordingly, "foreign patents are often so restricted in their protection that they are of insignificant or no commercial value." B. Pravel, *Why the United States Should Adopt the First-to-File System for Patents*, 22 ST. MARY'S L.J. 797, 807 (1991). Without the Doctrine of Equivalents, it would be impossible to obtain meaningful protection for an invention against a competitor who makes only insubstantial and unimportant changes.¹⁵ If, as Petitioner advocates, the Doctrine of Equivalents were to be eliminated from the United States patent scheme, the constitutionally mandated goal of "protecting the patentee" would be seriously undermined. More than 1.5 million presently unexpired patents written with the expectation of protection against infringement through the Doctrine of Equivalents would be thrown into question and significantly devalued.

The continued viability of the Doctrine of Equivalents is also necessary to encourage innovation and to spur technological progress. In order to encourage inventors to expand new technology frontiers, "the potential return [of seeking patent

15. "Japan has virtually no Doctrine of Equivalents" and is "a good example of why the Doctrine of Equivalents is so important." *See, supra, Moorhead* at 1444, n.125.

protection] must warrant the risk." *Hilton Davis*, 62 F.3d at 1531 (Newman, J., concurring). The advancement of the greater public interest must be a goal of the United States patent system. *Id.*; See also *Mazer v. Stein*, 347 U.S. 201, 219 (1954):

The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in Science and useful Arts. Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered.

If inventors are not adequately protected from infringement, they will choose to keep their inventions secret rather than disclosing them through the patent system. If that occurs, the promotion of "the Progress of Science and useful Arts" will fall by the wayside because the body of public domain knowledge, in the form of expired patents, will cease to grow. See, *supra*, *Moorhead* at 1427.

If a patentee were accorded patent protection only for the specific and literal language of his claimed invention, she would likely forego investing the necessary economic resources necessary to develop and exploit the invention. "[T]he economic risk in developing new technology is high, . . . the potential return must warrant the risk, and . . . the return must pay for the failures as well as the successes." *Hilton Davis*, 62 F.3d at 1531 (Newman, J., concurring). Narrowing the patent right by eliminating the Doctrine of Equivalents would make the entire patenting process unprofitable and eliminate the incentive to innovate. Kurt Glitzenstein, *A Normative and Positive Analysis of the Scope of the Doctrine of Equivalents*, 7 HARV. J. LAW AND TECH. 281, 328 (1994) [hereinafter *Scope of the Doctrine*].

Without a meaningful Doctrine of Equivalents, an infringer could "tickle" the patent by manufacturing, using, or selling a product that is the same as the patented invention and not be held liable for infringement. A patent would be nothing more than a roadmap to insubstantial changes. As the decision below recognizes, this would "encourage infringers 'to make unimportant and insubstantial changes and substitutions in the patent, which, though adding nothing, would be enough . . . [to evade] the reach of law'." *Hilton Davis*, 62 F.3d at 1517 (quoting *Graver Tank*, 339 U.S. at 607). If patent protection were not available in such circumstances, there would be no incentive to innovate and inventors would be disinclined to continue to push the technological envelope.

Additionally, "[t]he ability of the public successfully to design around — to use the patent disclosure to design a product or process that does not infringe, but like the claimed invention, is an improvement over the prior art — is one of the important public benefits that justify awarding the patent owner exclusive rights to his invention." *Id.* at 1520. "Designing around 'is the stuff of which competition is made and is supposed to benefit the consumer'." *Id.* (quoting *State Indus., Inc. v. A.O. Smith Corp.*, 751 F.2d 1226, 1236 (Fed. Cir. 1985)); See also, *supra*, *Scope of the Doctrine* at 292. This is particularly true in rapidly changing fields of technology, such as microelectronics and biological engineering, where "the doctrine of equivalents today serves the unexpected purpose of being the only readily available tool for application of the law to new technologies." *Hilton Davis*, 62 F.3d at 1532 (Newman, J., concurring). Because future technological advances cannot be known at the time a patent application is filed, it would be impossible to describe and claim them. See *SRI Int'l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121 (Fed. Cir. 1985); *Hughes Aircraft Co. v. United States*, 717 F.2d 1351, 1365 (Fed. Cir. 1983). If the Doctrine of Equivalents were not available today to protect inventors in rapidly changing high technology fields, the incentive to innovate would be severely chilled.

II. THE DECISION OF THE FEDERAL CIRCUIT IS ENTITLED TO SPECIAL DEFERENCE.

The Federal Circuit is a highly specialized tribunal, created "to reduce the widespread lack of uniformity and uncertainty of legal doctrine that exist[ed] in the administration of patent law." *Christianson v. Colt Indus. Operating Corp.*, 486 U.S. 800, 813 (1988) (quoting H.R. REP. NO. 312, 97th Cong., 2d Sess., at 23 (1981)). The Federal Circuit has *exclusive nationwide* jurisdiction of appeals in patent cases. 28 U.S.C. § 1295(a)(1). Because of this congressional mandate, this Court has recognized that Federal Circuit decisions are entitled to particular deference. *United States v. Fausto*, 484 U.S. 439, 464 (1988) ("Because of the unique character of the Federal Circuit, its conclusions are entitled to special deference by this Court. . . . Because its jurisdiction is confined to a defined range of subjects, the Federal Circuit brings to the cases before it an unusual expertise that should not lightly be disregarded.") (Stevens, J., dissenting).¹⁶

In the present case, the Federal Circuit has performed its statutory duty by restating the *Graver Tank* Doctrine of Equivalents, a principle unique to patent law. This is the *exclusive* appellate domain of the Federal Circuit. Whatever disagreement may have existed among a minority of that court about the Doctrine of Equivalents has been laid to rest by the *en banc* decision below. This Court should not disturb a decision by the court charged by Congress to unify the patent law, after spirited debate¹⁷, the enlightened wisdom of its full *en banc* membership,

16. The special patent expertise of the Federal Circuit incorporates that of its predecessor, the Court of Customs and Patent Appeals. *South Corp. v. United States*, 690 F.2d 1368, 1370 (Fed. Cir. 1982) (*en banc*).

17. The debate, as reflected in the Court's three questions, was fundamentally over the role of juries in deciding factual equivalence questions, not about the continued existence of the Doctrine or the wisdom of *Graver Tank*.

and the assistance of numerous *amici curiae*, which simply restates the *Graver Tank* Doctrine of Equivalents as wise and pragmatic law. Given the special expertise of the Federal Circuit on pure questions of patent law, it seems unlikely that this Court, which only rarely reviews such issues, could provide clearer guidance. Moreover, given that lower courts have experienced no difficulty in applying *Hilton Davis* and *Graver Tank*, it is entirely in accord with the congressional mandate and this Court's recognition of the Federal Circuit's special expertise to abstain from immediate review of the *Hilton Davis* decision until sufficient time has passed that the lower courts and the patent bar can assess its true impact, if any. Since the Federal Circuit's decision has not been decided "in a way that conflicts with relevant decisions of this Court," Sup. Ct. R. 10(c), there is no need to waste scarce judicial resources on reviewing a question that has been correctly and consistently answered for more than 40 years.

III. GRAVER TANK IS ENTIRELY CONSISTENT WITH THE 1952 PATENT ACT AND PRIOR PRECEDENT.

Petitioner argues that this Court should overturn *Graver Tank* because the 1952 Patent Act eliminated the Doctrine of Equivalents. Since Petitioner failed to raise that issue below, Respondent objects to this argument being made here for the first time. Further, and without waiving that objection, this Court has already disposed of that argument: "§ 271(a) of the new Patent Code [of 1952], which defines 'infringement,' left intact the entire body of case law on direct infringement." *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 342(1961).¹⁸ Giles Rich, one of the principal drafters of the 1952 Act and now a

18. The 1952 Patent Act added 35 U.S.C. § 271, which was the first statutory provision for patent infringement. S. REP. NO. 1979, 82d Cong., 2d Sess., reprinted in 1952 U.S.C.C.A.N. 2394, 2402 [hereinafter 1952 U.S.C.C.A.N.].

member of the Federal Circuit, explained: "[p]aragraph [271](a) defines direct infringement and is present only for the sake of completeness. We got along without it for 162 years and we could again. Its omission would change nothing." Giles Rich, *Infringement Under Section 271 of the Patent Act of 1952*, 35 J. PAT. OFF. SOC'Y 476, 491 (1953) [hereinafter *Infringement Under § 271*]. "Infringement" includes both literal infringement and infringement by equivalents. *Union Paper Bag Machine Co.*, 97 U.S. at 120; *Jurgens v. McKasy*, 927 F.2d 1552, 1560 (Fed. Cir. 1991) (Rich, J.) It is thus clear that this legislation did not affect the existing body of law underlying the Doctrine of Equivalents. Indeed, the 1952 Act tacitly adopted *Graver Tank* by not repudiating it.

The principal purpose of the 1952 Patent Act was "the codification of title 35, United States Code, and involves simplification and clarification of language and arrangement." 1952 U.S.C.C.A.N. at 2397. Notably, the Act and its legislative history make no express change in the then-existing law of the Doctrine of Equivalents. In fact, the portions of the Act relating to infringement *expanded* the patent protection by overturning certain Supreme Court decisions (e.g., *Mercoild Corp. v. Mid-Continent Investment Co.*, 320 U.S. 661 (1944)) which unduly restricted the rights of the patent owner in areas of contributory infringement and patent misuse.¹⁹ 1952 U.S.C.C.A.N. at 2402; *see also, supra, Infringement Under § 271* at 479, 489-90 ("[i]ts purpose is to correct an injustice and restore the equal protection of the patent law to all the types of inventions on which the statute authorizes the grant of patents"). In fact, *Graver Tank* was one of the few cases of its era where this Court did *not* restrict patent rights, and should therefore be given great deference in accord

19. Cf., the addition of § 103 (requiring that an invention be nonobvious) which "for the first time in our statute, provides a condition which exists in the law and has existed for more than 100 years, but only by reason of decisions of the courts." 1952 U.S.C.C.A.N. at 2399. No comparable addition was made for the Doctrine of Equivalents, which had also existed "for more than 100 years."

with congressional intent behind the 1952 Act. *See* Karl B. Lutz, *The New 1952 Patent Statute*, 35 J. PAT. OFF. SOC'Y 155, 156-57 (1953) ("[C]ongress, being cognizant of this changed attitude of the courts, has inserted in the new act some provisions which codify the 'common law' of patents as it existed prior to the recent apostasy from the benevolent policy of the Constitution").

Petitioner contends that congressional silence on the Doctrine of Equivalents in § 271 overturns prior precedent of this Court. It is illogical and at odds with basic principles of statutory interpretation to argue that while Congress expressly broadened protection afforded to patent owners in some areas, it silently retracted others. "The normal rule of statutory construction is that if Congress intends for legislation to change the interpretation of a judicially created concept, it makes that intent specific." *Midlantic National Bank v. New Jersey Dept. of Environmental Protection*, 474 U.S. 494, 501 (1986). Since there is no evidence that Congress has ever considered legislation affecting the Doctrine of Equivalents, it must be assumed that the rule of *Graver Tank* and its predecessors is correct. *Johnson v. Transportation Agency, Santa Clara County, California*, 480 U.S. 616, 629 n.7 (1986) ("Congress has not amended the statute to reject our construction, nor have any such amendments even been proposed, and we therefore may assume that our interpretation was correct.") This Court has instructed:

Congress is presumed to be aware of an administrative or judicial interpretation of a statute and to adopt that interpretation when it re-enacts a statute without change. [cites omitted] So too, where as here, Congress adopts a new law incorporating sections of a prior law, Congress normally can be presumed to have had knowledge of the

interpretation given to the incorporated law, at least insofar as it affects the new statute.

Lorillard v. Pons, 434 U.S. 575, 580-86 (1977).

Petitioner incorrectly argues that the term "equivalents" in 35 U.S.C. § 112 ¶ 6²⁰ evidences congressional intent to eliminate protection under the Doctrine of Equivalents. This provision was enacted not to affect the Doctrine of Equivalents, but to statutorily overturn *Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1 (1946). *In re Donaldson Co., Inc.*, 16 F.3d 1189, 1194 (Fed. Cir. 1994) (*en banc*). Further, the "equivalent" of 35 U.S.C. § 112 ¶ 6 is not related to the Doctrine of Equivalents. *Pennwalt Corp. v. Durand-Wayland*, 833 F.2d 931, 934 (Fed. Cir. 1987) (*en banc*) ("[s]ection 112, paragraph 6, plays no role in determining whether an equivalent function is performed by the accused device under the doctrine of equivalents"), *cert. denied*, 485 U.S. 961 (1988), and *cert. denied*, 485 U.S. 1009 (1988). 35 U.S.C. § 112 ¶ 6 defines *literal* infringement, and requires that a court find *identity* of the claimed *function* in the accused device. *Id.* If literal infringement or identity of function is not present, infringement may nevertheless still be found under the Doctrine of Equivalents. *Id.* To suggest that § 112 ¶ 6, eliminates the Doctrine of Equivalents is inconsistent with the legislative history and prior decisions. Moreover, as Petitioner acknowledges, Congress was aware of the Doctrine of Equivalents when it enacted § 112 ¶ 6. Pet. Br. at 25; hence, it is presumed that Congress' failure to repudiate *Graver Tank* is tacit recognition of its continued viability. *Johnson*, 480 U.S. at 629; *Lorillard*, 434 U.S. at 580-81.²¹

20. "An element in a claim . . . may be expressed as a means or step for performing a specified function" and "such a claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof."

21. Petitioner contends that § 251 of the 1952 Act provides for "the very
(Cont'd)

If as Petitioner asserts, the Doctrine of Equivalents is flawed and inconsistent with the patent statutes, Congress would certainly have addressed these alleged shortcomings in the last 45 years:

[T]he powers of Congress to legislate upon the subject of patents is plenary by the terms of the Constitution, and as there are no restraints on its exercise, there can be no limitation of their right to modify [the patent laws] at their pleasure, so long as they do not take away the rights of property in existing patents. *McClurg v. Kingsland*, 42 U.S. (1 How.) 202, 206 (1843).

(Cont'd)

sort of correction of mistakes that the judicial doctrine of equivalents serves to accomplish." Pet. Br. at 26. Reissue is designed to correct mistakes where a "patent is . . . deemed wholly or partially inoperative or invalid . . . by reason of the patentee claiming more or less than he had a right to claim." 35 U.S.C. § 251. The patentee "may obtain a new patent to replace the old one." 1952 U.S.C.C.A.N. at 2400. The purpose of the Doctrine of Equivalents is not to correct mistakes, but to prevent an infringer from making "unimportant and insubstantial changes and substitutions in the patent which, though adding nothing, would be enough to take the copied matter outside the claim, and hence outside the reach of law." *Graver Tank*, 339 U.S. at 607. "[S]ome technologic variants can be reached only through litigation invoking the doctrine of equivalents." *Hilton Davis*, 62 F.3d at 1536 (Newman, J., concurring.) Further, Patent reissue statutes were enacted in 1832 (4 Stat. 55), 1836 (5 Stat. 117) and 1946 (35 U.S.C. § 46). The 1952 Act did not change the types of errors for which reissue could be sought. *In re Wadlinger*, 496 F.2d 1200, 1207 n.7 (CCPA 1974) (Rich, J.); see also *Union Asbestos & Rubber Co. v. Paltier Corp.*, 298 F.2d 48, 50-52 (7th Cir. 1962). Consequently, this Court was well aware of the distinction between reissue and the Doctrine of Equivalents when it decided *Graver Tank*. See 339 U.S. at 614-16 (reissue adequately protects patentees without doctrine of equivalents) (Black, J., dissenting).

Since Congress has not acted, it must be assumed that the rule of *Graver Tank* and its predecessors is consistent with the 1952 Act. *Johnson*, 480 U.S. at 629 n.7. Since Congress has not interfered, this Court should abstain as well.

Petitioner argues that the Doctrine of Equivalents expands the scope of a patent to include protection outside the patent claim — an interpretation soundly rejected by this Court. In *Graver Tank*, this issue was clearly in the Court's mind, but did not preclude application of the Doctrine of Equivalents. *Graver Tank*, 339 U.S. at 615 n. 3 ("the courts have no right to enlarge a patent beyond the scope of its claim as allowed by the Patent Office" (Black, J., dissenting)). The Federal Circuit is of a like view:

To say that the doctrine of equivalents extends or enlarges *the claims* is a contradiction in terms. The claims — i.e., the scope of patent protection *as defined by* the claims — remain the same and application of the doctrine [of equivalents] *expands the right to exclude* to "equivalents" of what is claimed.

Wilson Sporting Goods v. David Geoffrey & Assoc., 904 F.2d 677, 684 (Fed. Cir. 1990) (Rich, J.), *cert. denied*, 498 U.S. 992 (1990).

The patent grant has always been interpreted as extending to substantial equivalents *ab initio*. See, e.g., *Union Paper Bag Machine Co. v. Murphy*, 97 U.S. 120, 125 (1878) ("[a]uthorities concur that the substantial equivalent of a thing, in the sense of the patent law, is the same as the thing itself"); *accord Sanitary Refrigerator*, 280 U.S. at 42. The initial patent grant includes all inventions literally defined by the patent claims, as well as those

having only insubstantial differences from the literally claimed invention — in the eyes of the law, these are the same thing. See *Winans*, 56 U.S. at 343 ("patentee . . . deemed to claim every form in which his invention may be copied.") This Court has made clear that the law interprets a claim to cover equivalents without the need for the patentee to expressly state that equivalents were being claimed. *Id.*²²

Petitioner would have patents construed narrowly — limited to their literal terms. That has never been the goal of our patent system:

Patents for inventions are not to be treated as mere monopolies and, therefore, odious in the eyes of the law; but they are to receive a liberal construction, and under the fair application of the rule, *ut res magis valeat quam pereat* [that the thing may rather have effect than be destroyed,] are if practicable, to be so interpreted as to uphold and not to destroy the right of the inventor.

Turrill v. Michigan Southern & Northern Indiana Ry. Co., 68 U.S. 491, 510 (1864). The courts have always strived to "construe . . . patents fairly and liberally, and not to subject them to any over-nice and critical refinements." *Ames v. Howard*, 1 F. Cas. 755, 756 (C.C.D. Mass. 1833) (No. 326) (Justice Story); see also *Winans*, 56 U.S. at 341:

22. Even the Patent Office has always considered patent claims to include equivalents:

An inventor is always entitled to equivalents — that is to say, to devices which operate in substantially the same way to accomplish substantially the same result in a combination. *Ex parte Cook*, 1890 C.D. 81, 82.

[S]pecifications are to be construed liberally, in accordance with the design of the Constitution and the patent laws of the United States, to promote the progress of the useful arts, and allow inventors to retain to their own use, not any thing which is matter of common right, but what they themselves have created.

Petitioner contends that the Doctrine of Equivalents promotes uncertainty and is inconsistent with the requirement of precise claiming required by the patent statutes. This Court in *Graver Tank* reached its decision over a dissent which raised that same argument. *See Graver Tank*, 339 U.S. at 613-14 (Black, J., dissenting). Further, as Petitioner concedes, the claiming requirement was contained in the Patent Acts of 1836 and 1870, long before *Graver Tank* and the 1952 Act. 5 Stat. 117, 119; 16 Stat. 198, 201. In its decision below, the Federal Circuit carefully analyzed this argument, concluding "[t]he Supreme Court explained that the doctrine is not inconsistent with the requirement for explicit claims." *Hilton Davis*, 62 F.3d at 1526.

The Doctrine of Equivalents is not, as Petitioner suggests, a different kind of infringement. There is only one cause of action under 35 U.S.C. § 271: for infringement. There has never been a decisional or statutory distinction between the legal effect of literal infringement and infringement under the Doctrine of Equivalents. The Doctrine of Equivalents is not a separate cause of action; "Patentees . . . are entitled in all cases to invoke to some extent the doctrine of equivalents." *Seymour v. Osborne*, 78 U.S. (11 Wall.) 516, 556 (1870). Since the claims are deemed to cover equivalents *ab initio*, there can be no separation of the cause of action for infringement.

Petitioner argues that the Doctrine should be applied only in cases where the infringer acts in subjective bad faith. This Court in *Graver Tank* reached its decision over a dissent which raised

that same argument. *See Graver Tank*, 339 U.S. at 612-13 (Black, J., dissenting). Infringement, whether literal or under the Doctrine of Equivalents, has never depended upon the subjective intent of the infringer or any other "equitable" factors. *See, e.g., Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 478 (1974) ("[t]his protection goes not only to copying the subject matter, . . . but also forbids independent creation"). "Equity" applied to the Doctrine of Equivalents means only "general fairness." *Things Remembered, Inc. v. Petrarca*, 1995 U.S. LEXIS 8531 at 17 (1995) (citing *Hilton Davis*) (Ginsburg, J. concurring). Nor is Petitioner's analogy to "breathing space" in libel actions valid; there is a constitutional right to free speech; there is no such right to infringe a patent, knowingly or otherwise.

IV. THE DECISION OF THE FEDERAL CIRCUIT ACCURATELY RESTATES GRAVER TANK.

The Federal Circuit has not strayed from the mandate of this Court's decision in *Graver Tank*, but merely took the "opportunity to restate — not revise — the test for infringement under the doctrine of equivalents." *Hilton Davis*, 62 F.3d at 1516. Contrary to Petitioner's argument, the Federal Circuit was not left "to its own devices." Pet. Br. at 19. The Court did what it promised — faithfully restating in clear and practical language, the fundamental *Graver Tank* principle — fulfilling the role Congress envisioned for that court. Petitioner's assertion that the Court felt "constrained" to follow *Graver Tank* and "not free to rethink the doctrine" assumes there is something to "rethink." Since there is nothing "broken" about the Doctrine of Equivalents or *Graver Tank*, the Federal Circuit properly found nothing to "fix." Notably, none of the experienced trial or appellate jurists below expressed a longing for a world without this Doctrine.

In *Graver Tank* this Court held that infringement may be found if the accused device "performs substantially the same function in substantially the same way to obtain the same result"

as the patented invention. *Graver Tank*, 339 U.S. at 608 (quoting *Sanitary Refrigerator Co.*, 280 U.S. at 42). This neat, memorable phrase is merely one way of applying the Doctrine of Equivalents. "Equivalence, in the patent law, is not the prisoner of a formula, and is not an absolute to be considered in a vacuum." *Id.* at 609. It must be "determined against the context of the patent, the prior art, and the particular circumstances of the case." *Id.* When looking at the "particular circumstances of the case", this Court cited several factors which must be considered, including "whether persons reasonably skilled in the art would have known of the interchangeability of an ingredient", whether there is evidence of copying, and whether the accused item was developed by independent research. *Id.* at 609, 612. "[U]nder the circumstances of this case . . . is a change of such *substance* as to make the doctrine of equivalents inapplicable; or conversely, whether under the circumstances the change was so insubstantial that the . . . invocation of the doctrine of equivalents was justified." *Id.* at 610 (emphasis added). Thus, this Court made clear that it is the *substantiality* of the change which determines whether or not two devices are "equivalent."²³ The "final determination requires a balancing of credibility, persuasiveness and weight of the evidence." *Id.* at 609-10.

Faithfully following this precedent, the Federal Circuit held that ". . . the application of the doctrine of equivalents rests on the substantiality of the differences between the claimed and accused products or processes." *Hilton Davis*, 62 F.3d at 1518. In determining the "substantiality of the differences," the Federal Circuit restated the law of *Graver Tank* that the trier of fact may

23. The adoption by *Graver Tank* and the Federal Circuit of a factual three part test (function/way/result) with consideration of other objective evidence of equivalence (interchangeability, copying, designing around) is the direct analog of another well-known patent law principle using a three part factual inquiry and consideration of objective evidence of nonobviousness to determine validity. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966).

use the function/way/result test, as well as look to all of the circumstances of the case, such as the known interchangeability of an element, the lack of independent research and development, and the evidence of copying. *Id.* at 1518-20.

Nor is the Doctrine "an equity-based form of relief" — it is clearly a jury question. See, e.g., *Graver Tank*, 339 U.S. at 609 ("finding of equivalence is a determination of fact."); *Royer v. Schultz Belting Co.*, 135 U.S. 319 (1890); *Tyler v. Boston*, 74 U.S. (7 Wall.) 327 (1868); *Winans*, 56 U.S. at 338. The present case is thus distinguishable from situations where only questions of law are presented. Cf., *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995), *cert. granted*, 116 S. Ct. 40 (1995).²⁴

Finally, Petitioner argues that it is unfair to "punish" infringers based on a jury's determination of what meets the "nebulous" standard of "insubstantial differences." *Graver Tank* forecloses that argument. Nor is the "insubstantial difference" standard any more difficult for a jury to deal with than other factual intellectual property concepts such as "substantial similarity" in copyright or "likelihood of confusion" in trademarks. See, e.g., *Ford Motor Co. v. Summit Motor Products, Inc.*, 930 F.2d 277 (3d Cir. 1991), *cert. denied*, 112 S. Ct. 373 (1991) (copyright); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992) (trademark).

24. *Markman* involves the question of whether the legal issue of claim interpretation should be removed from the jury. Claim interpretation has always been for the court; infringement (whether literal or by equivalents) for the jury. In the present case, there is no issue of impingement on a party's Seventh Amendment jury rights. See 62 F.3d at 1522.

CONCLUSION

For the foregoing reasons, the petition for writ of certiorari should be denied.

Respectfully submitted,

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December 6, 1995